Remarks

In the first and second paragraphs of the Official Action, Examiner rejected claims 1-16 under 35 U.S.C. 103(a) as being unpatentable over Stewart in view of D'Amico. This rejection is respectfully traversed.

This application has a filing date of February 11, 2000. Stewart was filed November 30, 2000, or more than nine months after this application. D'Amico was filed February 9, 2001, about a year after this application. Although both of the published applications claimed priority from provisional applications, the files of the provisional applications are unavailable to determine whether the claimed features were disclosed in those provisional applications. Thus, the provisionals are unavailable as prior art. The publications relied upon by Examiner are not prior to the filing date of this application, and thus, they are not prior art under 35 U.S.C. 103 or 35 U.S.C. 102. Because Examiner has cited no prior art references on which to base the rejection, the rejection is improper. There being no further rejections, claims 1-16 are allowable.

In the Response to Arguments section of the Official action, Examiner refers applicant to MPEP 706.02. However,

706.02 only supports Applicants' position, not Examiner's, for several reasons.

1. Examiner is misreading MPEP 706.02.

MPEP 706.02(a) states in pertinent part (with emphasis added), "The examiner must also determine the issue or publication date of the reference so that a proper comparison between the application and reference dates may be made." The distinction between the application and a reference is an important one to keep in mind when reading MPEP 706.02.

MPEP 706.02 has a base portion, and then many sub portions (e.g. 706.02(a)), but the base portion provides rules for determining the effective date of the application. This doesn't apply to an application used as a reference, it just applies to applicants' application. Examiner's is correct in that the base portion of 706.02 does contain language regarding the effective filing date of the application, but Examiner cannot apply that language as the basis of identifying the publication date of a reference. The application in the base portion of 706.02 is what *applicant* submitted, it is not the reference which Examiner is attempting to assert.

Applicants have performed a thorough examination of MPEP 706.02, yet could find no language that identifies that a published patent application for which the date of an unpublished and unavailable provisional patent application, which may or may not contain even a part of the information in the patent, may be used as the date of the published application, in any section that is not describing the priority date of applicants' application, which would not apply to the reference. Nor does it make any sense for the office to allow such a thing: neither Examiner nor applicant has reviewed the provisional applications to determine whether they disclosed the subject matter of the claims. Furthermore, the file history of the published application has been reviewed by neither Applicants nor Examiner to ensure that the published application is entitled to claim priority from the provisional. Is there at least one common inventor? The cross reference information we have doesn't say. Did the application claim priority from the provisional before the provisional was abandoned? Was the application filed with all the required elements: at least one claim and the filing fee? Neither the file history nor the provisional is available to us for all of these issues to be checked.

For purpose of traversal, we cannot assume any of this. Therefore, applicant traverses on the basis that we have no evidence of common inventorship between the provisionals and the published applications, we have no evidence that the filing fee and a claim was submitted with the application, and that we have no evidence that the claim for priority was properly made. Furthermore, we traverse on the basis that we have no evidence that the provisionals contain the cited portions of the published applications in a manner that one skilled in the art could make or use the inventions. We have none of this and we cannot assume any of it.

Examiner must allow Applicants to review all references and argue them in the interests of fairness. The provisional applications Examiner relies upon could state almost anything. It isn't fair for Examiner to simply assume that they state what is stated in the published applications. Examiner is asking Applicants to give up claim scope, and yet, in the end it is entirely possible that either the provisional doesn't match the reference application or the reference application is not entitled to the filing date of the provisional, making any change in claim scope to be entirely unnecessary.

Nowhere else is Examiner permitted to make this sort of assumption without showing proof. For example, MPEP 2144.03 requires proof of well known prior art, and the cited references are hardly well known. 706.02(b) requires that a patent be issued before the date of a provisional application is used as the date of the patent so that both parties can discuss whether the pertinent disclosure in the issued patent is entitled to the date of the provisional, yet Examiner's approach would make a published application harder to overcome than a printed patent for the reasons described above: the records are unavailable to us to use to challenge Examiner's assertions.

Furthermore, the 35 U.S.C. 102 requires a basis for using a reference as prior art. On what basis does Examiner assert that the references used qualify as prior art? They are not 102(a) or (b) prior art because the references supplied are well after the 102(a) and (b) critical dates, which require printing or publication more than one year prior to the filing date of applicants' application. They do not apply as 102(e) prior art either. 35 U.S.C. 102(e) provides, in pertinent part, "(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent". The provisionals were not published, and there is no statutory basis for giving the published applications the date of the provisionals, nor is it at all fair or reasonable to give the published applications the date of secret provisionals.

Examiner has shown no basis for use of the art cited. Examiner uses the MPEP rules for assigning the priority date of the application in order to assign a publication date to the reference, a date to which it may or may not be entitled. Examiner does this unfairly, without opportunity for Applicants to make any sort of reasoned argument that the provisional applications filed with the USPTO did in fact disclose the claimed invention.

The references are not entitled to the dates Examiner has assigned them. Not having provided any rejections based on permissible art, the claims are patentably distinguishable over the cited references.

Examiner is requested to withdraw the rejection or to enter this amendment into the record for purpose of appeal.

Respectfully submitted,

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